

## **REMARKS**

The Office action has been carefully considered. In the Office Action dated June 15, 2007, claims 1-9, 11-19, 21-33, 35-43, and 44-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0083435 A1 to Blasko et al. ("Blasko") in view of U.S. Patent Application No. 2005/0226142 A1 to Rand ("Rand"). Further, claims 10, 20, 34, and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blasko in view of Rand and in further view of U.S. Patent No. 6,950,623 to Brown ("Brown"). Applicants respectfully disagree.

By present amendment, claims 1, 7, 25, 31, 49, and 50 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

### **35 U.S.C. §103 Rejections**

Turning to the claims rejected under §103, amended claim 1 recites:

In a client system, a method of operation comprising  
    providing an advertisement publisher with a profile of the user of  
client system at a predetermined time prior to streaming of a program;  
    caching, at a client cache, a plurality of advertisements of  
various time lengths prior to streaming of a program; and  
    causing one or more of said cached advertisements to be  
synchronously rendered during an advertisement time slot of a  
streaming program, replacing advertisements, if any, included in the  
streaming program for the advertisement time slot.

Claims 25 and 49 recite similar language. The Office Action rejected claim 1, 25 and 49 as being unpatentable over Blasko in view of Rand. In specific with respect to the language of claim 1, the Office Action contends that Blasko teaches caching a plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 35, line 5 to par. 36, line 5 of Blasko are referenced. Further, the Office Action contends that Blasko teaches causing one or more of said cached

advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 51, lines 1-6, par. 53, and par. 26 to par. 27 of Blasko are referenced.

The Office Action acknowledges that Blasko fails to teach providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation at par. 11, par. 20, lines 1-5, at par. 22. The Office Action concludes that the recitations of claim 1 would have been obvious to one skilled in the art at the time of the invention because the selective insertion of media data into a data stream as taught by Rand yields the advantage of optimally customizing a subscriber's data stream by analyzing content preferences and demographic profiles. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office Action has failed to establish a *prima facie* case for obviousness. There is no disclosure anywhere in Blasko, Rand, or any other prior art of record that teaches or even suggests the concept of providing an advertisement publisher with a profile of the user of the client system at a predetermined time prior to streaming of a program in combination with storing advertisements in a local cache prior to delivery of streaming content. Furthermore, even if one somehow construed the cited and applied sections of Blasko and Rand to teach these recitations, it does not seem likely that a person of ordinary skill in the

art would have had reason to combine these two references. These prior art limitations are discussed further below.

As discussed in previous Office Action responses, Blasko teaches a system and method for injecting advertisements into a stream of television programming upon the detection of a display device being on and currently operating. Such a system is able to detect whether or not a display device associated with a set top box (STB) is turned on and currently receiving and displaying a signal from the STB. As such, a head end programming provider is better able to determine whether or not injected advertising will actually be seen based on the assumption that if a display device is turned on then an audience is watching. Detecting whether or not a display devices on, however, simply does not reveal any meaningful demographic information about any such viewing audience. That is, absolutely no information about a profile related to a user of the system can be construed, and subsequently provided to an advertising publisher, simply by detecting whether or not the display device is on or off.

In the Office Action, it is correctly recognized that Blasko does not teach or suggest providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation within the context of claim 1. Applicants respectfully disagree.

The Office Action also contends that Blasko combined with the teaching of Rand would render the recitations of claim 1 obvious to a person skilled in the art at the time the invention was made. This conclusion does not seem warranted. Blasko teaches a system that features previously stored ads, *i.e.*, locally cached advertisements, that are wholly and completely unrelated to the any user profile (as acknowledged by the Office Action). However, Blasko is fully capable of delivering the content in real-time when the set-top box is determined to be “on.” Thus, the unique problem of delivering content in real-time while the STB is on is remedied while the content remains unrelated, *i.e.*, not tailored to the client system. Somewhat similar, but distinctly different, Rand teaches a system capable of delivering content more tailored to the user system, but does not teach, much less is even capable of, storing such tailored content at a local cache. As such, the specific

problem of delivering content from a remote location to a local client system in a tailored manner is solved, but at the expense of delivering the content from a local cache such that efficiency of delivery is not impacted.

Additionally, these references teach away from each other as Blasko teaches efficient local storage and delivery at the expense of tailoring the content to the client while Rand teaches tailoring the content at the expense of efficient local storage and delivery. The recitations of claim 1, however, solve this issue in a new and non-obvious manner by providing a system that provides an advertisement publisher with a profile of the user of client system at a predetermined time prior to streaming of a program and also caches a plurality of advertisements of various time lengths prior to streaming of a program at a client cache. As a result, content is delivered in an efficient and local manner while also being tailored to profile information of the client system.

Further, Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscriber's predetermined preferences. In specific, paragraph 20 of Rand describes that insertion of media may be based on a number of factors including age, education, sex, viewing history, and geographic location. Delving further into Rand however, it is stated that this kind of subscriber preference data is stored in a metadata module 135 which is clearly separate and distinct from the provider's network 150. Thus, it should not be construed that the provider network is capable of "providing an advertisement publisher with a profile of the user of client system" as recited in claim 1. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone "providing an advertisement publisher with a profile of the user of client system."

Therefore, nowhere in Rand, let alone in the cited paragraphs (11, 20, and 22) is there a teaching or suggestion of "providing an advertisement publisher with a profile of the user of client system." The Office Action also acknowledges that Blasko fails to teach this recitation as well, and, therefore, each and every element

of Claim 1 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Further yet, to suggest that one skilled in the art would have obviously looked to a system that has already assembled and stored information about a subscriber such as the case in Rand to be combined with a system of Blasko to actively look to retrieve information that has already been retrieved is illogical. Rand does not teach providing a profile about a subscriber to an advertisement publisher because Rand has already separately and distinctly assembled its own set of profile data. It is merely conclusive to simply show that a system uses profile information (Rand) and then turn around and construe using profile information to be the same as a system that is capable of "providing an advertisement publisher with a profile of the user of client system." Such broad, conclusory statements do not adequately address the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as Rand has absolutely no need for seeking additional duplicative profile information.

Applicants respectfully submit that dependent claims 2-6 and 10-24 by similar analysis, are allowable. Each of these claims depends directly from claim 1 and consequently includes the recitations of claim 1. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. Even when additional prior art is introduced, as is the case with Brown as cited and applied with regard to claims 10 and 20, the prior art of record still fails to teach or suggest all of recitations of the pending claims. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Claim 25 recites similar language to claim 1 in an apparatus. The Office Action rejected claim 25 as being unpatentable over Blasko in view of Rand. In specific, the Office Action contends that Blasko teaches storage medium having

stored therein programming instructions designed to enable the apparatus to cache a plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Further, the Office Action contends that Blasko teaches causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 28, par. 30, lines 11-12, par. 5, line 5 to par. 36, line 6 of Blasko are referenced. Par. 26 to par. 27 of Blasko is referenced.

The Office Action acknowledges that Blasko fails to teach providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation at par. 11, par. 20, lines 1-5, at par. 22. The Office Action concludes that the recitations of claim 25 would have been obvious to one skilled in the art at the time of the invention because the selective insertion of media data into a data stream as taught by Rand yields the advantage of optimally customizing a subscriber's data stream by analyzing content preferences and demographic profiles. Applicants respectfully disagree.

Again, applicants submit that the Office Action has failed to establish a *prima facie* case for obviousness. As discussed above, there is no teaching anywhere in Blasko, Rand, or any other prior art of record that teaches or even suggests the concept of providing an advertisement publisher with a profile of the user of the client system prior to the streaming of a program. Furthermore, even if one were to construe the cited and applied sections of Rand to somehow teach this recitation, the motivation to combine these two references, as cited in applied by the office action, is highly suspect.

The Office Action contends that Blasko combined with the teaching of Rand would render the recitations of claim 25 obvious to a person skilled in the art at the time the invention was made. As discussed above, this is an erroneous conclusion that flies in the face of common sense. Clearly, these references teach away from each other as Blasko teaches efficient local storage and delivery at the expense of tailoring the content to the client while Rand teaches tailoring the content at the expense of efficient local storage and delivery. The recitations of claim 25, however,

solve this issue in a new and non-obvious manner by providing a system that provides an advertisement publisher with a profile of the user of client system at a predetermined time prior to streaming of a program and also caches a plurality of advertisements of various time lengths prior to streaming of a program at a client cache. As a result, content is delivered in an efficient and local manner while also being tailored to profile information of the client system.

Rand does not remedy the deficiency in the teachings of Blasko. Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscriber's predetermined preferences. Delving further into Rand however, it is stated that this kind of subscriber preference data is stored in a metadata module 135, which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network is capable of "providing an advertisement publisher with a profile of the user of client system" as recited in claim 25. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone "providing an advertisement publisher with a profile of the user of client system."

In the Office Action, it is correctly recognized that Blasko does not teach or suggest providing an advertisement publisher with a profile of the user of client system. Nowhere in Rand, let alone in the cited paragraphs (11, 20, and 22) is there a teaching of "providing an advertisement publisher with a profile of the user of client system." Therefore, each and every element of claim 25 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Applicants respectfully submit that dependent claims 26-30 and 34-48 by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 25 and consequently includes the recitations of claim 25. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 25 and therefore these claims are also allowable

over the prior art of record. Even when additional prior art is introduced, as is the case with Brown as cited in applied with regard to claim 34 and 44, the prior art of record still fails to teach or suggest all of recitations of the pending claims. In addition to the recitations of claim 25 noted above, each of these dependent claims includes additional patentable elements.

Claim 49 recites a similar language to claims 1 and 25 including the recitation "provide an advertisement publisher with a profile of a user of said client prior to streaming of a program." The Office Action acknowledges that Blasko does not teach this recitation. Rand does not remedy this deficiency in the teachings of Blasko. Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscribers' predetermined preferences. Rand teaches that this kind of subscriber preference data is stored in a metadata module 135 which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network that can "provide an advertisement publisher with a profile of the user of client system" as recited in claim 49. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone "providing an advertisement publisher with a profile of the user of client system." Therefore, each and every element of claim 49 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained.

Furthermore, to suggest that one skilled in the art would have obviously looked to a system that has already assembled and stored information about a subscriber such as the case in Rand to be combined with a system of Blasko to actively look to retrieve information that has already been retrieved is illogical. It is overly broad and conclusive to simply show that a system uses profile information (Rand) and then turn around and construe using profile information to be the same as a system that is capable of "providing an advertisement publisher with a profile of the user of client system." Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of



obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as Rand has absolutely no need for seeking additional duplicative profile information.

Applicants respectfully submit that dependent claims 53-55, by similar analysis, are allowable. Each of these claims depends directly from claim 49 and consequently includes the recitations of claim 49. As discussed above, Blasko and Rand, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 49 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 49 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, claim 7 recites:

In a client system, a method of operation comprising:  
    adaptively retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system;  
    providing an advertisement publisher with a profile of the user of client system at a predetermined time prior to streaming of a program;  
    caching, at a client cache, said plurality of advertisements of various time lengths; and  
    causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot.

Independent claims 31 and 50 recite similar language. The Office Action rejected claims 7, 31, and 50 as being anticipated by Blasko. In specific, the Office Action contends that Blasko teaches adaptively retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system. Par. 29, lines 4-15, par. 33, lines 10-14, par. 46, par. 57, and par. 60 of Blasko are referenced. Further, the Office Action contends that Blasko teaches caching said plurality of advertisements of various time lengths. Par. 28, par. 30, lines 11-12, par. 5, line 5 to

par. 36, line 6 of Blasko are referenced. Further yet, the Office Action contends that Blasko teaches causing one or more of said cached advertisements to be synchronously rendered during an advertisement time slot of a streaming program, replacing advertisements, if any, included in the streaming program for the advertisement time slot. Par. 26 to par. 27 of Blasko is referenced.

The Office Action acknowledges that Blasko fails to teach providing an advertisement publisher with a profile of the user of client system. However, the Office Action contends that Rand does teach this recitation at par. 11, par. 20, lines 1-5, at par. 22. The Office Action concludes that the recitations of claim 25 would have been obvious to one skilled in the art at the time of the invention because the selective insertion of media data into a data stream as taught by Rand yields the advantage of optimally customizing a subscriber's data stream by analyzing content preferences and demographic profiles. Applicants respectfully disagree.

As discussed above, Blasko teaches a system for “targeted advertising, such as in television programming, such as in television programming delivery systems utilizing set top boxes”. Among other differences, the cited and applied reference fails to teach, disclose or suggest the element of “providing an advertisement publisher with a profile of the user of client system” from a client system as claimed in amended independent Claims 7, 31, and 50. Nor does the cited and applied reference teach, disclose, or suggest sending any subscriber information from a client system. As discussed more fully below, Claims 7, 31, and 50, and their dependent claims clearly recite such elements and the Office Action has admitted that similar recitation in other pending independent claims are not taught by Blasko.

With respect to the arguments put forth for claim 7, the Office Action contends that Blasko combined with the teaching of Rand would render the recitations of claim 7 obvious to a person skilled in the art at the time the invention was made. This is an erroneous conclusion that flies in the face of common sense. Blasko teaches a system that features previously stored ads, *i.e.*, locally cached advertisements, that are wholly and completely unrelated to the any user profile (as acknowledged by the Office Action). However, Blasko is fully capable of delivering the content in real-time when the set-top box is determined to be “on.” Thus, the

unique problem of delivering content in real-time while the STB is on is remedied while the content remains unrelated, *i.e.*, not tailored to the client system. Somewhat similar, but distinctly different, Rand teaches a system capable of delivering content more tailored to the user system, but does not teach, much less is even capable of, storing such tailored content at a local cache. As such, the unique problem of delivering content from a remote location to a local client system in a tailored manner is solved, but at the expense of delivering the content from a local cache such that efficiency of delivery is not impacted.

These references teach away from each other as Blasko teaches efficient local storage and delivery at the expense of tailoring the content to the client while Rand teaches tailoring the content at the expense of efficient local storage and delivery. The recitations of claim 7, however, solve this issue in a new and non-obvious manner by providing a system that provides an advertisement publisher with a profile of the user of client system at a predetermined time prior to streaming of a program and also caches a plurality of advertisements of various time lengths prior to streaming of a program at a client cache. As a result, content is delivered in an efficient and local manner while also being tailored to profile information of the client system.

Further, Rand teaches a method for a provider in a media-on-demand network to selectively insert media items into a media stream based on a set of subscriber's predetermined preferences. In specific, paragraph 20 of Rand describes that insertion of media may be based on a number of factors including age, education, sex, viewing history, and geographic location. Delving further into Rand however, it is stated that this kind of subscriber preference data is stored in a metadata module 135 which is clearly separate and distinct from the provider's network 150. Thus, it cannot possibly be construed that the provider network is capable of "providing an advertisement publisher with a profile of the user of client system" as recited in claim 7. Additionally, in Rand, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in Rand with the advertisers 170, let alone "providing an advertisement publisher with a profile of the user of client system."

Therefore, nowhere in Rand, let alone in the cited paragraphs (11, 20, and 22) is there a teaching of “providing an advertisement publisher with a profile of the user of client system.” The Office Action also acknowledges that Blasko fails to teach this recitation as well, and, therefore, each and every element of claim 7 has not been shown to be taught somewhere in the prior art of record and rejection based on §103 cannot be maintained. Therefore, applicants submit that claims 7, 31, and 50 are allowable over the prior art of record for least these reasons.

Applicants respectfully submit that dependent claims 8-9, 32-33, and 51-52 by similar analysis, are allowable. Each of these claims depends directly from its respective independent claim, (claims 7, 31, or 50) and consequently includes the recitations of its independent claim. As discussed above, Blasko fails to disclose the recitations of these independent claims and therefore these dependent claims are also allowable over the prior art of record. In addition to the recitations of claim 7, 31, and 50 noted above, each of these dependent claims includes additional patentable elements.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

### **CONCLUSION**

Applicants submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to Axios Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,  
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Date: October 15, 2007 by: /Adam L.K. Philipp/

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